

REMARKSI. Examiner Interview

On behalf of Applicants, the undersigned Attorney wishes to thank the Examiner for the courtesy of the telephonic interview of today's date in connection with the referenced application.

II. Advisory Action

On December 19, 2002, Applicants submitted a response to the final Office Action, mailed November 26, 2002. An Advisory Action issued on January 9, 2003. The Advisory Action indicates that the response to the final rejection is not deemed to place the application in condition for allowance. Accordingly, claim 1 is rejected under 35 U.S.C. §112, first paragraph, for the reasons of record.

Amended claim 1 provides that medium chain glycerides and mixtures thereof are excluded from the class of lipids which may be used as an additive in the claimed invention. The Examiner alleges that there is no support for the exclusion. Applicants respectfully disagree.

III. Description of the Claimed Invention

The disclosure appearing on page 6, lines 12-19, of the specification is *not* a disclosure of a preferred embodiment of the claimed invention. Rather, the disclosure appearing on page 6, lines 12-19, is a description of a generic class of medium chain glycerides disclosed in international application number PCT/SE98/01790. Examples of preferred additives for use in the claimed invention are set forth in the preceding paragraph at lines 1-10. None of the preferred lipids disclosed at page 6, line 3, is a medium chain glyceride.

At page 4, lines 27-28, of the specification, it is disclosed that medium chain glycerides disclosed in PCT/SE98/01790 are excluded from the class of lipids which may be used in the claimed invention. Applicants submit that there is congruence between the respective disclosures appearing at page 4, lines 27-28 and page 6, lines 12-19. Therefore, these two disclosures must be read together. When the two disclosures are read together, it is evident that, at the time the application was filed, medium chain glycerides disclosed in PCT/SE98/01790 were excluded from the class of lipids which may be used in the claimed invention. In this regard, the Examiner's attention is directed to original claim 1, lines 13-18, which provides that medium chain glycerides, e.g., those medium chain glycerides disclosed in PCT/SE98/01790, are excluded. Furthermore, none of the Examples discloses a formulation comprising a bisphosphonate and a medium chain glyceride.

For all of the foregoing reasons and the reasons set forth in Applicants' previous response, Applicants respectfully submit that the §112, first paragraph, rejection is improper and withdrawal thereof is respectfully requested.

As discussed in Applicants' previous response, the specification contains certain inadvertent clerical errors which appear in the specification and which apparently went unnoticed at the time of filing. At page 5, lines 15-24, combinations of additives are disclosed. From this disclosure, it appears that lipids and non-lipids, including those disclosed in the PCT/SE98/0179, are included within the scope of the invention. However, the disclosure at page 5, lines 15-24 is inconsistent with the overwhelming weight of evidence that the claimed invention (See original claim 1) excludes medium chain glycerides and mixtures thereof (See page 4, lines 27-28; page 6, lines 12-19; and the Examples). Moreover, at page 5, lines 19-20, medium chain glycerides

are incorrectly characterized as an example of a phospholipid. The person of ordinary skill in the art knows that a phospholipid is not a medium chain glyceride.

Notwithstanding the unintentional clerical errors appearing in the specification at page 5, lines 15-24, withdrawal of the §112 rejection is proper when original claim 1 and the specification, as originally filed, is considered in its entirety.

The office Action provides that claims 2-21, 23, 40-42 and 45-46 are objected to as being dependent on a rejected claims. The claim objection will become moot upon withdrawal of the §112 rejection.

The Examiner's attention is also directed to claim 47 which was introduced by the Preliminary Amendment, filed October 5, 2001.

CONCLUSION

Applicants submit that pending claims 1-21, 23-34, 40-42 and 45-47 are in condition for allowance, which action is earnestly solicited. The Assistant Commissioner is hereby authorized to charge Deposit Account No. 23-1703 in the event that any fee is required in connection with this communication.

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Respectfully submitted,



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